

REMARKS

Applicant has carefully considered the Board's Decision on Appeal, and respectfully submits that the application, as amended, is in condition for allowance. Presently, claims 15-27 and 43 are pending.

THE BOARD'S DECISION

In the Decision on Appeal dated May 28, 2004, the Board:

- reversed rejection of claim 43 under 35 U.S.C. §102(a) as anticipated by Rosner (U.S. Pat. No. 6,387,361);
- reversed rejection of claims 15-27 under 35 U.S.C. §102(b) as anticipated by Bremer et al. (U.S. Pat. No. 5,643,874);
- reversed rejection of claims 15-27 under 35 U.S.C. §102(e) as anticipated by Patel et al. (U.S. Pat. No. 6,309,663); and
- issued a new rejection of claim 43 under 35 U.S.C. §102(e) as anticipated by Rosner.

REJECTIONS UNDER 35 U.S.C. §102(e) AS ANTICIPATED BY ROSNER

The Board rejected claim 43 under 35 U.S.C. §102(e) as anticipated by Rosner. Applicant has amended claim 43 to recite "a sustained release acarbose formulation." Support for the amendment is found on page 2, line 18 of the application (first sentence of paragraph [0009] in Pub. No.: US 2002/0147159). Applicant submits that the amendment overcomes the rejection.

ADDITIONAL AMENDMENT TO SPECIFICATION

Applicant has amended the last paragraph on page 4 of the specification, extending to the top of page 5 (paragraph [0019] in Pub. No.: US 2002/0147159) to recite that "[a]carbose is an oral alpha-glucosidase inhibitor ...", rather than an alpha-glucoside inhibitor. Incorrect use of glucoside rather than glucosidase was identified by the Board in their Decision (see page 4 of the May 28, 2004 Decision on Appeal). Support for the amendment is found on page 1, first paragraph of the application (paragraph [0001] in Pub. No.: US 2002/0147159), where acarbose is described as "an inhibitor of the saccharase enzyme complex ..." Enzymes conventionally have the suffix "ase". Therefore, as an inhibitor of an enzyme complex, acarbose is an alpha-glucosidase inhibitor. The amendment does not add new matter.

Conclusion

In light of the foregoing, Applicant respectfully submits that the pending claims are in condition for allowance. Applicant respectfully requests an indication thereof.

Respectfully Submitted,

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